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| SERIAL NUMBER | FILING DATE | FIRST NAMED APPLICANT | ATTORNEY DOCKET NO. |
|---------------|-------------|-----------------------|---------------------|
| 08/542,793 | 10/13/95 | SULLIVAN | M P-3724-1/SLD |

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| EXAMINER | |
|-----------|--------------|
| GRAHAM, M | |
| ART UNIT | PAPER NUMBER |
| 3304 | |

DATE MAILED:

10/16/96

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents

| | | |
|------------------------------|--------------------------------------|---------------------------------|
| Office Action Summary | Application No. 08/542,793 | Applicant(s) Sullivan |
| | Examiner Mark S. Graham | Group Art Unit 3304 |

Responsive to communication(s) filed on Jul 30, 1996

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

Claim(s) 1-8 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

Claim(s) _____ is/are allowed.

Claim(s) 1-8 is/are rejected.

Claim(s) _____ is/are objected to.

Claims _____ are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The proposed drawing correction, filed on _____ is approved disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some* None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) _____.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 1-8 are rejected under 35 U.S.C. § 103 as being unpatentable over Nesbitt in view of Nakamura for the reasons set forth in the previous action.

The applicant's have essentially argued that the claimed materials are an improvement over the materials recited in Nesbitt in that they offer greater cut resistance and greater distance while retaining the same relative relationship disclosed by Nesbitt - a softer outer layer for greater playability characteristics and a harder inner layer for greater distance. However, the materials recited by the applicant are not in and of themselves novel as disclosed by Nakamura. Because the desired relationship was disclosed and known to the ordinarily skilled artisan in Nesbitt, and better cut resistance and greater

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distance are always desired by those working in the art, it remains the examiner's opinion that it would have been obvious for the ordinarily skilled artisan to have utilized materials known to exhibit such properties (see Nakamura) in fashioning Nesbitt's ball while maintaining the essential relative relationship between the inner and outer cover layers.

Nothing about the combination set forth would have been unobvious or unexpected to the ordinarily skilled artisan.

Regarding claims 2 and 3 there it is not required that the prior art ball meet U.S.G.A. standards.

Applicant's arguments filed 7/30/96 have been fully considered but they are not deemed to be persuasive.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

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Any inquiry concerning this communication should be directed to Mark S. Graham at telephone number (703) 308-1355.

MSG
08 October 1996

MARK S. GRAHAM
PRIMARY EXAMINER
GROUP 3300